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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FUMIO SHIMIZU, NOBUO NAKAMUARA, HIDEAKI
MIYAUCHI, and TAKESHI KAWAMURA

Appeal 2010-001410
Application 10/560,358
Technology Center 2100

Before: JOSEPH L. DIXON, LANCE LEONARD BARRY, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Patent Examiner rejected claims 1, 4, 7, and 8. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

INVENTION

The Appellants describe the invention at issue on appeal as follows.

[A]n editing device with a control means for controlling a processing means so as to process only the necessary parts out of edit material based on a list and for controlling a registration means so as to register only a processing result of the necessary parts in an external device as an editing result.

(Spec. 2.)

ILLUSTRATIVE CLAIM

4. An editing method of executing an editing process based on a list specifying edit details and registering an obtained editing result in an external device, comprising:

performing a prescribed process on edit material;

registering the editing result in the external device;

controlling said performing of the prescribed process and registering of the editing result so as to perform the process on only necessary parts out of the edit material and so as to register only a result of the process of the necessary parts in the external device as the editing result, wherein

 said controlling controls said performing of the prescribed process so as to perform the process on only necessary parts out of the edit material based on the list and controls said registering so as to register only a result of the process of the necessary parts as the editing result in the external device when the list being created is reproduced according to external operation in a creation mode of the list, wherein

when a batch registration mode is set, and a registration request of the editing result based on the list entered by external operation is given after the list is finished, said controlling controls said performing of the prescribed process so as to perform the process on only necessary parts of which a result of the process has not been registered in the external device, out of the necessary parts out of the edit material, and controls said registering so as to register a result of the process of the necessary parts in the external device as the editing result, and wherein

when a sequential registration mode is set, and a sequential part registration request is received when the list is being created, said controlling controls said performing the prescribed process so as to perform the process and controls said registering so as to register a sequential result of the process on only necessary parts that have not been registered in the external device.

REJECTIONS

Claims 1 and 4 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Pub. No. 2003/0206203 A1 ("Ly").

Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ly and U.S. Patent Application Pub. No. 2003/0219226 A1 ("Newell").

ISSUE

The *issue* before us is whether the Examiner erred in finding that Ly discloses batch processing as required by independent claims 1 and 4.

FINDINGS OF FACT

Ly describes its invention as "a collaborative free-form environment for generating, viewing, and flexibly arranging data." (¶ 0009.)

ANALYSIS

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933, 69 USPQ2d 1283, 1286 (Fed.Cir. 2003) (internal citations omitted).

CLAIM CONSTRUCTION

"[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

Here, independent claims 1 and 4 recite in pertinent part the following limitations: "a batch registration mode is set." We disagree with the Examiner that "[b]atch processing is commonly defined as the serial execution of items." (Ans. 8.) Instead, we believe that a person of ordinary skill in the art in question at the time of the invention would have understood "batch" to "[p]ertain[] to a system or mode of operation in which inputs are collected and processed all at one time, rather than being processed as they arrive, and a job, once started proceeds to completion without additional input or user interaction." The IEEE Standard Dictionary of Electrical and

Electronics Terms, 81-82 (6th ed. 1997.) Giving the words of the independent claims their ordinary and customary meaning, therefore, we construe claims 1 and 4 to require a mode in which edits are collected and processed all at one time, rather than being processed as they arrive, and an editing job, once started proceeds to completion without additional input or user interaction.

CLAIM COMPARISON

"It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim, and that anticipation is a fact question . . ." *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)).

Here, the Examiner makes the following findings.

The collaboration framework of Ly is a batch processing framework. Clients share modifications with other clients (paragraph 0089). Once a modification is made, the modification is propagated to other clients (paragraph 0089). Based upon acceptance, the propagated change is made (paragraph 0089). All changes within the collaboration environment of Ly serial changes, and require approval prior to becoming incorporated (paragraph 0089).

(Ans. 8.)

For its part, the paragraph of Ly cited by the Examiner explains that its "collaboration framework . . . allow[s] clients to share their modifications, in near real time, with other clients. When a user modifies the document, that collaborative edit is substantially immediately routed to

all other interested parties via a collaboration server." (Ly ¶ 0089.) "In a specific implementation, changes are propagated as proposed changes that are presented to users for acceptance." (*Id.*)

However, we agree with the Appellants that "Ly does not disclose that the actual editing . . . is performed by batch processing . . ." (Reply Br. 9.) To the contrary, we find that the reference teaches the opposite of batch processing. More specifically, rather than collect edits and process them all at one time as in batch processing, Ly immediately routes each collaborative edit to all other interested parties as they occur. (¶ 0089.) Rather than allowing a started job to proceed to completion without additional input or user interaction, moreover, the Examiner admits that "[a]ll changes within the collaboration environment of Ly serial changes, and require approval prior to becoming incorporated (paragraph 0089)." (Ans. 8.)

The Examiner does not allege, let alone show, that the addition of Newell cures the aforementioned deficiency of Ly. Therefore, we *conclude* that the Examiner erred in finding that Ly discloses batch processing as required by independent claims 1 and 4.

DECISION

We reverse the rejection of claims 1 and 4 and that of claims 7 and 8, which depend therefrom.

REVERSED

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